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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/612,219 | 07/02/2003 | John Sheridan Richards | 600.1281 | 5761 |
| 23280 | 7590 | 04/29/2005 | | |
| DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018 | | | | |
| | | | EXAMINER HAMDAN, WASSEEM H | |
| | | | ART UNIT 2854 | PAPER NUMBER |

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---|--|
| Office Action Summary | Application No. 10/612,219 | Applicant(s) RICHARDS, JOHN SHERIDAN | |
| | Examiner Wasseem H. Hamdan | Art Unit 2854 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/17/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I (claims 1-6, 8-12, 14-20) in the reply filed on 04/07/2005 is acknowledged.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 1, lines 3-4 recites the limitation (step) "using plate making equipment, the plate or image making equipment varying the mark", the step has no clear technical support in the specification.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The newly added limitations of claim 1 are not shown in any of the drawings, i.e. the limitation "using plate making equipment, the plate or image making equipment varying the mark." This structure must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

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should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because:
 - a. Box 200 requires a descriptive legend such as “controller”;
 - b. Box 220 requires a descriptive legend such as “motor”;
 - c. Box 230 requires a descriptive legend such as “motor”;
 - d. Box 40 requires a descriptive legend such as “folder”;
 - e. Boxes 24 and 34 require descriptive legends such as “sensors”;
 - f. Box 200 requires a descriptive legend such as “controller”;
 - g. Box 50 requires a descriptive legend such as “platemaking equipment”;
 - h. Boxes 80 and 82 require descriptive legends such as “main image area”
 - i. Boxes 70 and 72 require descriptive legends such as “mark”;
 - j. Boxes 122 and 222 require descriptive legends such as “printing plate”; and
 - k. Box 90 requires a descriptive legend such as “handheld sensor”.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claim 1 is objected to because of the following informalities: the newly added limitation appears to be inaccurate, the claim recites "providing a mark on a first printing form using plate or image making equipment, the plate or image making equipment varying the mark as a function of a desired preset phase for a motor driving the first printing form during printing" wherein the examiner believes that the applicant means that the mark varies on different printing forms. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 8, 10-12, 14, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al. (US Patent 4,694,749) in view of Richard Geoffrey Warren (UK Patent GB 2 298 985).

Regarding claims 1 and 14, Warren discloses a method and apparatus for presetting motor phase in a web printing press [FIG. 2; column 2, lines 19-48] comprising the steps of:

providing a mark [column 1, lines 44-45] on a first printing form [column 1, line 45 (printing form means the same as printing plate)] as a function of a desired preset phase for a motor driving the first printing form during printing [column 1, lines 46-48]. Since the cylinder (printing form) is driven by the motor, the phase deviations of the plate cylinder is the same as the phase deviation of the motor, as the motor is the driving force. As disclosed in Takeuchi et al. in column 1, lines 34-60, "Each sensor detects the phase deviation of the plate cylinders to carry out a registration operation", and column 2, lines 49-64 disclose "error correcting means for changing the rotational phase of each plate cylinder in response to the signal from the control means", i.e. when the mark position is changed accordingly];

reading the mark using a sensor, the sensor having a sensor output [column 1, lines 42-47] ; and

presetting the phase of the motor as a function of the sensor output [column 1, line 43].

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Regarding claim 14, Takeuchi et al. discloses a controller [column 1, line 55] for determining the first preset motor phase information as a function of the output of the first sensor [column 1, lines 42-60].

Takeuchi et al. discloses the essential elements of the claimed invention, but Takeuchi et al. is silent about using plate making equipment, the plate or image making equipment varying the mark. However, Warren discloses using plate making equipment, the plate or image making equipment varying the mark [page 2, lines 1-19]. In Warren the plate calibration information is in the form of bar-coded data, which it is different for every calibration which is the same as the claim language using plate making equipment, the plate or image making equipment varying the mark]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Takeuchi et al. by including using plate making equipment, the plate or image making equipment varying the mark, since using the plate making equipment, the plate or image making equipment varying the mark, would be beneficial for the purpose of providing enhancements for setup and control of the printing press and hence a better quality printing image.

Regarding claim 2, Takeuchi et al. discloses wherein the desired preset phase is a function of a physical position of the mark on the first printing form [column 1, lines 42-47].

Regarding claims 3 and 4, Takeuchi et al. discloses wherein the mark includes information related to the desired preset phase [column 1, lines 42-47].

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Regarding claim 5, Takeuchi et al. discloses wherein the printing form is a lithographic printing plate [column 1, line 14; offset printing press is the same as lithographic printing, please see Handbook of print media, page 52, section 1.3.2.3, a copy is included (and in PTO 892 form) in the office action)].

Regarding claim 6, Takeuchi et al. discloses wherein the mark [m] is located outside a main image area of the printing plate [column 1, line 45 (printing form means the same as printing plate)].

Regarding claim 8, Takeuchi et al. discloses wherein the sensor reads the mark when the first printing form is on the printing press [m; 61; column 14, lines 35-61].

Regarding claim 10, Takeuchi et al. discloses a second mark [FIG. 2; 61] on a second printing form [FIG. 2; column 2, lines 34-35; 55-56], the second mark being a function of a desired preset phase for a second motor [20] driving the second printing form during printing, the first and second printing forms printing different webs [FIG. 2; 61; 2a; 20-26].

Regarding claim 11, Takeuchi et al. discloses calculating the desired preset phase for a specific job [column 11, lines 44-60].

Regarding claim 12, Takeuchi et al. discloses storing the desired preset phase [column 1, lines 40-41].

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Regarding claim 16, Takeuchi et al. discloses a second printing group for printing a second web and having at least one second drive motor and at least one second printing form, the second printing form having a second mark providing second preset motor phase information for presetting the second drive motor to a second preset phase [FIG. 2; 61; 2a; 20-26].

Regarding claim 20, Takeuchi et al. discloses the essential elements of the claimed invention except for the mark being a bar code. Warren discloses that the mark is a bar code [page 4, lines 5-6]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Takeuchi et al. by making the mark a bar code, since Warren teaches that having the mark as a bar code would be beneficial for the purpose of including various barcodes that can be changeable and machine readable marks [Warren: page 2, line 3; page 4, line 2].

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al. (US Patent 4,694,749) in view of Richard Geoffrey Warren (UK Patent GB 2 298 985) as applied to claims 1-6, 8, 10-12, 14 and 16 above, and further in view of Banke (US Patent 4,872,407).

Regarding claim 9, Takeuchi et al. and Warren together disclose the essential elements of the claimed invention except for wherein the sensor reads the mark prior to placement of the printing plate on the printing press. Banke discloses a sensor that reads a mark prior to placement of the printing plate on the printing press [6, 5, 1; Abstract]. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to

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further modify the teachings of Takeuchi et al. by including the sensor that reads the mark prior to placement of the printing plate on the printing press, since having the sensor that reads the mark prior to placement of the printing plate on the printing press would be beneficial for the purpose of properly positioning the plate on the cylinder.

9. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al. (US Patent 4,694,749) in view of Richard Geoffrey Warren (UK Patent GB 2 298 985) as applied to claims 1-6, 8, 10-12, 14 and 16 above, and further in view of Chretienat et al. (US Patent 6,167,806 B1).

Regarding claim 15, Takeuchi et al. discloses having a cutting device for cutting the web into signatures, the first preset motor phase information being a function of a reference position of the cutting device [column 4, lines 20-22].

Takeuchi et al. and Warren together disclose the essential elements of the claimed invention except for a folder. Chretienat et al. discloses a folder [10; column 6, lines 41-43]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to further modify the teachings of Takeuchi et al. by including a folder, since having a folder would be beneficial for the purpose of folding the printing material after being cut, storing and delivering it to the user, basically to make up a specific product such as magazines or newspapers as taught by Chretienat et al.

Regarding claim 17, Takeuchi et al. and Warren together disclose the essential elements of the claimed invention except for that the controller that controls the first and the second

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drive motors. Chretienat et al. discloses that the controller controls the first and the second drive motors [6; column 6, lines 44-47]. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify the teachings of Takeuchi et al. by including a controller that controls the first and the second drive motors, since having a second printing group for printing a second web would be beneficial for folding the printing material after being cut, storing and delivering it to the user, basically to make up a specific product such as magazines or newspaper as taught by Chretienat et al.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al. (US Patent 4,694,749) in view of Richard Geoffrey Warren (UK Patent GB 2 298 985) as applied to claims 1-6, 8, 10-12, 14 and 16 above, and further in view of Hunold et al. (US Patent 6,165,732 B2).

Regarding claim 18, Takeuchi et al. and Warren together disclose the essential elements of the claimed invention except for a printing form imaging device connected to the controller for creating the mark. Hunold et al. discloses a printing form imaging device connected to the controller for creating the mark [column 7, lines 34-46; 53-64; column 8, lines 15-17]. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify the teachings of Takeuchi et al. by including a printing form imaging device connected to the controller for creating the mark, since having a printing form imaging device connected to the controller for creating the mark would be beneficial for the purpose of having just one printing device for the printing plate and the register mark in one machine.

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11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al. (US Patent 4,694,749) in view of Richard Geoffrey Warren (UK Patent GB 2 298 985) as applied to claims 1-6, 8, 10-12, 14 and 16 above, and further in view of Huston (US Patent 5,816,165).

Regarding claim 19, Takeuchi et al. and Warren together disclose the essential elements of the claimed invention except for measuring a distance of the mark from an edge of the first printing form. Hunold et al. discloses measuring a distance of the mark from an edge of the first printing form [d₀; column 3, lines 4-10]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to further modify the teachings of Takeuchi et al. by including measuring a distance of the mark from an edge of the first printing form, since having to measure a distance of the mark from an edge of the first printing form would be beneficial for the purpose of giving indication of how far the mark is from the beginning of the cylinder.

Response to Arguments

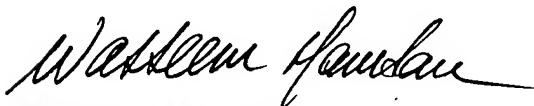
12. Applicant's arguments filed on 03/17/2005 have been fully considered but they are moot in view of the new ground of rejections set forth above.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wasseem H. Hamdan whose telephone number is (571) 272-2166. The examiner can normally be reached on M-F (first Friday off) 6:30 AM- 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Wasseem H. Hamdan

April 19, 2005



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